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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/889,699	09/25/2001	Alain Riondel	ATOCM 220	7408

23599 7590 12/22/2005

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EXAMINER

SOLOLA, TAOFIQ A

ART UNIT PAPER NUMBER

1626

DATE MAILED: 12/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/889,699

Applicant(s)

RIONDEL ET AL.

Examiner

Taofiq A. Solola

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) 10, 11, 14 and 15 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1</u> . | 6) <input type="checkbox"/> Other: ____. |

Art Unit: 1626

Claims 1-15 are pending in this application.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10, 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hess et al., US 4,745,214.

Applicant claims a process of making quaternary ammonium salts of formula (I) comprising reaction of N,N-dimethyl-aminoethyl acrylate (DAMEA) with a quaternizing agent of formula (II) in the presence of water. In a preferred embodiment, at least one stabilizing agent is added at 20 to 2000 ppm of the ammonium salt. The reaction temperature is 35 to 65°C.

Determination of the scope and content of the prior art (MPEP §2141.01)

Hess et al., teach a process of making quaternary ammonium salts of formula (I) comprising reaction of N,N-dimethyl-aminoethyl acrylate (DAMEA) with quaternizing agent of formula (II) in the presence of water. In a preferred embodiment, a stabilizing agent is added at 100 to 1500 ppm of the ammonium salt. The reaction temperature is 30-60°C. See the abstract, column 4, lines 1-10 and the examples.

Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)

The difference between the instant invention and that of Hess et al., is that applicant claims a preferred embodiment of at least one stabilizing agent being added at 20 to 2000 ppm of the ammonium salt, and the reaction temperature is 35 to 65°C, while Hess et al., teach a

Art Unit: 1626

preferred embodiment of adding a stabilizing agent at 100 to 1500 ppm of the ammonium salt, and the reaction temperature is 30-60° C.

Finding of prima facie obviousness---rational and motivation (MPEP §2142.2413)

However, the temperature ranges are so close as to be insignificant and changing the amount of the stabilizer is an obvious modification available to the special preference of an artisan. It is a mere optimization of a variable, which is not patentable absent unexpected result due to the variable, which is different in kind and not merely in degree from that of the prior art. *In re Aller*, 22 F.2d 454, 105 USPQ 233 (CCPA, 1955). Therefore, the instant invention is prima facie obvious from the teaching of Hess et al. One of ordinary skill in the art would have known to make the modifications at the time this invention was made. The motivation is to optimize the yield of the product.

Double Patenting Rejection

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Art Unit: 1626

Claim 11 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-2 of U.S. Patent No. 5,912,383. Although the conflicting claims are not identical, they are not patentably distinct from each other because in US '383, R1 in the product is both H and methyl, while in the instant claim R1 is H.

Claim 10 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 8 of U.S. Patent No. 5,919,974, claim 14 as obvious over claims 1, 8, 14 of US '974 and claim 15 as obvious over claims 1, 2, 8 of US '974. Although the conflicting claims are not identical, they are not patentably distinct from each other because in US '974, R in formula (II) is methyl, while in the instant it is methyl or benzyl.

Allowable Subject Matter

Claims 1-9, 12-13 are allowable over prior arts of record for not having a stabilizer and/or a sequestering agent as reagent.

Telephone Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taofiq A. Solola, PhD, JD, whose telephone number is (571) 272-0709.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Joseph McKane, can be reached on (571) 272-0699. The fax phone number for this Group is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1600.

Art Unit: 1626



TAOFIQ SOLOLA
PRIMARY EXAMINER
Group 1626

December 14, 2005